

REMARKS

Applicant thanks the Examiner for the thorough consideration given the present application. Claims 1-5, 7, 11, 12, 14-16, 21, 22, 29, and 30 are pending. Claims 6, 8-10, 13, 17-20, 23-28, and 31-34 are cancelled without prejudice or disclaimer, Applicant reserving the right to file one or more continuing applications directed to the subject matter of the cancelled claims.

Insofar as they may relate to the pending claims, Applicants traverse the rejection of claims 1, 2, 4-7, 11, 12, 14-18, 21, 22, and 24-36 under 35 U.S.C. §103(a) as being unpatentable over Treyz (U.S. 6,587,835) in view of Esposito (U.S. 6,587,838), as well as the rejection of claims 3 and 19 as being unpatentable over Treyz and Esposito in view of Semple (U.S. 6,408,307).

While not acquiescing to any rejection, but merely to expedite prosecution, independent claims 1 and 21 are amended to recite a shopping assistance service method and system having a combination of steps, including delivering to a user at least one of comparative-pricing and availability data for identified items for other business premises relative to a location.

Amended independent claims 1 and 21 require the comparative pricing and/or availability data to be categorized according to zones of different physical accessibility of the business premises concerned from a location associated with information about an item of interest at the business premises where the item is offered.

Amended claims 1 and 21 also require other business premises to be categorized into zones of differing user accessibility, a feature formerly included in claim 21 but not mentioned in the Office Action regarding claim 21. While the categorizing step of cancelled claim 6 is discussed in the Office Action, the analysis of claim 6 is incorrect.

In rejecting claim 6 as being obvious over Treyz and Esposito, the Office Action incorrectly says FIG. 12 of Treyz shows organizing data output according to identified zones of different accessibility from a location determined to be associated with captured information about an item of interest at a business premise where the item is being offered. However, the portion of Treyz describing FIG. 72 (column 45, line 65, through column 46, line 23) simply says an information screen provided to a parent shows the current location of the mobile device user and a history list of locations visited and the purchases made at those locations. Clearly, this has nothing to do with the feature of categorizing business premises into zones of differing user accessibility.

If the Examiner is relying on inherency for the foregoing feature, he is reminded of the requirements for such reliance. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578,

581-82, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981). To establish inherency, extrinsic evidence must make clear that the missing descriptive matter is **necessarily** present in the thing described in the reference and that it would be so recognized by persons of ordinary skill in the art. Inherency may not be established by possibilities or probabilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Roberston*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). In relying upon a theory of inherency, the Examiner must provide a basis in fact or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (B.P.A.I. 1990)

The Examiner has made no attempt to satisfy these requirements. If the Examiner persists in this position, he is requested to indicate specifically the basis of his decision that FIG. 72 of Treyz discloses the foregoing feature.

Since independent claims 1 and 21 are allowable, the remaining dependent claims are also allowable. Semple (U.S. 6,408,307), previously relied on for features of dependent claims 3 and 19, does not disclose the previously discussed features of independent claims 1 and 21.

In view of the foregoing amendments and remarks, it is respectfully submitted that independent claims 1 and 21 are allowable. The remaining claims are also allowable due to

dependence, directly or by extension, on allowable independent claims 1 and 21, as well as for the additional limitations provided by these claims. Favorable reconsideration and allowance of the application are, therefore, deemed in order.

To the extent necessary during prosecution, Applicant hereby requests any required extension of time not otherwise requested and hereby authorizes the Examiner to charge any required fees not otherwise provided for, including extension of time and extra claims fees, to Deposit Account No. 07-1337.

Respectfully submitted,

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